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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ROANE, AARON F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,134	Applicant(s) WELLMAN ET AL.	
	Examiner Aaron Roane	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al. (USPN 5,891,142).

Regarding claim 1, Eggers et al. disclose a surgical ablation instrument, comprising: a first member (distal portion of 54 and counterparts in alternate embodiments) having a first insulative tissue-opposing portion (58 and counterparts in alternate embodiments) and a first tissue-contacting conductive element (62 and counterparts in alternate embodiments) extending along a length of the first insulative tissue-opposing portion and having a substantially circular cross-sectional shape extending along a length thereof, the first tissue-contacting conductive element being in communication with a source of ablative energy (10); and a second member (distal portion of 56 and counterparts in alternate embodiments) having a second insulative tissue-opposing portion (60 and

counterparts in alternate embodiments) and a second tissue-contacting conductive element (64 and counterparts in alternate embodiments) extending along a length of the second insulative tissue-opposing portion and having a substantially circular cross-sectional shape extending along a length thereof, the second tissue-contacting conductive element being in communication with the source of ablative energy (10), and the second member being pivotally coupled to the first member (figure 1 and 14) and including a distal, tissue-piercing tip (distal tip of 64) adapted to be deployed into tissue to allow the first tissue-contacting conductive element to be positioned on a first tissue surface and the second tissue-contacting conductive element to be positioned on a second tissue surface opposed to the first tissue surface such that ablative energy can be transmitted between the first and second tissue-contacting conductive elements, see col. 6-19 and figures 1-26A.

Regarding claims 2 and 3, Eggers et al. disclose the claimed positions and movability between the first and second members, see col. 6-19 and figures 1-26A.

Regarding claims 4 and 11, Eggers et al. further disclose the first and second members are elongate and each member includes a proximal end mated to the actuating member, in the form of handles (ridged portions of 36 and 38 in alternate embodiment), and a distal portion having the tissue-contacting conductive element disposed thereon, see col. 6 and figure 1.

Regarding claim 7, 8 and 10, Eggers et al. further disclose the device is bipolar, a first conductor element (lead corresponding to 28) extending from the first conductive element and adapted to communicate with the source of ablative energy; and a second conductor element (lead corresponding to 30) extending from the second conductive element and adapted to communicate with the source of ablative energy, and the insulative portions are disposed around the tissue-contacting conductive elements, see col. 6 and 7 and figures 1-3.

Claims 1-4, 6-8, 10, 11, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooven (USPN 6,086,586).

Regarding claims 1, 6 and 13, Hooven discloses a surgical ablation instrument, comprising: a first member (22) having a first insulative tissue-opposing portion (50) and first and third tissue-contacting conductive elements (42 and 44) extending along a length of the first insulative tissue-opposing portion and having a substantially circular cross-sectional shape extending along a length thereof, the first tissue-contacting conductive elements being in communication with a source of ablative energy (12); and a second member (24) having a second insulative tissue-opposing portion (52) and second and fourth tissue-contacting conductive elements (46 and 48) extending along a length of the second insulative tissue-opposing portion and having a substantially circular cross-sectional shape extending along a length thereof, the second tissue-contacting conductive element being in communication with the source of ablative energy (20), and the second

member being pivotally coupled to the first member and including a distal, tissue-piercing tip (point adjacent distal end of 52) adapted to be deployed into tissue to allow the first tissue-contacting conductive element to be positioned on a first tissue surface and the second tissue-contacting conductive element to be positioned on a second tissue surface opposed to the first tissue surface such that ablative energy can be transmitted between the first and second tissue-contacting conductive elements, see col. 3-5 and figures 1-5.

Regarding claims 2 and 3, Hooven further discloses the claimed positions and movability between the first and second members, see col. 3-5 and figures 1-5.

Regarding claims 4, 11 and 15, Hooven further discloses the first and second members are elongate and each member includes a proximal end mated to the actuating member, in the form of handles (ring 30 and other elongated ring), and a distal portion having the tissue-contacting conductive element disposed thereon, see col. 3-5 and figures 1-5.

Regarding claim 7, 8, 10 and 16, Eggers et al. further disclose the device is bipolar, a first conductor element (lead corresponding to 28) extending from the first conductive element and adapted to communicate with the source of ablative energy; and a second conductor element (lead corresponding to 30) extending from the second conductive element and adapted to communicate with the source of ablative energy, and the

insulative portions are disposed around the tissue-contacting conductive elements, see col. 6 and 7 and figures 1-3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooven (USPN 6,086,586) in view of Swanson et al. (USPN 6,610,055 B1).

Regarding claim 9, Hooven discloses the claimed invention except for explicitly reciting that at least one of the first and second members is malleable. Swanson et al. disclose an electrosurgical forceps device and teach "the forceps-like apparatus 150 includes arms 154 and 156 that are pivotably secured to one another by a pin 158 to allow the device to be opened and closed. The proximal portions of the arms 154 and 156 may be formed from rigid or malleable material. The arm distal portions 160 and 162, which are curved and support the tissue coagulation apparatus 152, are preferably formed from malleable material. This allows the arm distal portions 160 and 162 to be re-shaped by the physician as needed for particular procedures and body structures (note the dash lines in

FIG. 21), see col. 16, line 63 through col. 17, line 10 and figures 21-25. Arms 154 and 156 are analogous to the first and second members. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Hooven, as taught by Swanson et al., to provide the first and second members in a malleable form in order to be re-shaped by the physician as needed for particular procedures and body structures.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooven (USPN 6,086,586) in view of Tetzlaff et al. (USPN 6,511,480 B1).

Regarding claim 12, Hooven discloses the claimed invention except for explicitly reciting that the first and second members are biased in the closed position. Tetzlaff et al. disclose a bipolar forceps device and teach providing the forceps with ratchet system (32 and 34) in order to maintain a closure of the jaws, see col. 5, line 51 through col. 6, line 3 and figures 1, 3 and 8. There fore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Hooven, to provide the forceps with ratchet system in order to maintain a closure of the jaws and keep the jaws in a closed position.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 6-13, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R. *A.R.*
October 5, 2006

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER